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10/623,822	07/21/2003	Aaron Kiss	7395-03657	5741

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EXAMINER

VASUDEVA, AJAY

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,822

Applicant(s)

KISS, AARON

Examiner

Ajay Vasudeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 10-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1,3-7 and 10-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- A sail sheet depicting informational material that remains viewably undistorted whether the sheet is in a planar orientation or an airfoil orientation, as set forth in claims 1, 15 and 22. (emphasis added).
- Printing the informational matter onto an outer surface of at the webs of PVC vinyl, as set forth in claim 4.
- The sheet including an opaque barrier layer disposed between the scrim and the web of PVC, as set forth in claims 6, 13 and 16.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.**

- A sail sheet depicting informational material that remains viewably undistorted whether the sheet is in a planar orientation or an airfoil orientation, as set forth in claims 1, 15 and 22. (emphasis added).
- The sheet including an opaque barrier layer disposed between the scrim and the web of PVC, as set forth in claims 6, 13 and 16.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should

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include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4, 6, 13, 15, 16 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification, **as originally filed**, in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- In claims 1, 15 and 22, applicant claims a sail sheet depicting informational material that remains viewably undistorted whether the sheet is in a planar orientation or an airfoil orientation. (emphasis added).
- In claim 4, applicant claims printing the informational matter onto an outer surface of at the webs of PVC vinyl.

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- In claims 6, 13 and 16, applicant claims the sheet including an opaque barrier layer disposed between the scrim and the web of PVC.

However, there is no description of the above highlighted limitations in the original specification to suggest that the inventor had possession of the claimed invention at the time the application was filed.

5. Claims 1, 4, 6, 13, 15, 16 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, as detailed above in item #4 of this Office action, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Because the original specification provided no description of the limitations highlighted in items #4 of this Office action, it would not have enabled one skilled in the art to make and/or use the invention, as being claimed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-5, 7, 10-12, 14, 15, and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrka et al. in view of Doyle et al, and further in view of the teaching of the Internet site <http://na.northsails.com/Graphics/NGproducts.html> .

Rohrka et al. shows a planar, stretch-oriented sail sheet having a non-woven polyester yarn laminated between at least two webs of PVC vinyl (column 2, lines 40-50). Such coextruded sheet would lay flat against a planar surface. The presence of the polyester yarn between the webs of PVC vinyl would provide some degree of opaqueness to the sail sheet.

Rohrka et al. is silent on:

- (i) the scrim yarn being cross-hatched in a predetermined directional pattern, or
- (ii) informational matter being printed on to the sheet, or
- (iii) the sail material having a weight in the range of 15-30 ounces per square yard, or an adhesion strength of 20 pounds per two inches between the two webs of vinyl.

Doyle et al. shows a sailcloth having a scrim [12] of non-woven polyester yarn, wherein the yarn is cross-hatched in a predetermined directional pattern (column 1, lines 15-20, line 32, line 48 and lines 64-69).

It would have been obvious for one of ordinary skill in the art to have made the scrim of Rohrka et al. with a yarn that is cross hatched in a predetermined directional pattern, as taught by Doyle et al. Having such a cross-hatched scrim would have been advantageous as it would

have provided structural strength to the scrim, making it dimensionally stable by allowing equal distribution of stress, and thereby extending the operational life of the sail.

It is noted that it is common for the sails to depict printed informational material – either a manufacturer/user's logo, and/or an identification numbering in sporting events, as taught by the Internet site <http://na.northsails.com/Graphics/NGproducts.html>. It would have been obvious for one skilled in the art at the time of the invention to have printed informational matter on the sail of Rohrka et al. according to the teaching of the above Internet site, wherein the informational matter would have displayed an advertisement or a message according to the individual choice and needs of the manufacturer or the user. Printing such informational matter would have allowed the manufacturer to advertise their brand of product, as well as enable easy identification of the user's craft. Additionally, it would have allowed a user to display commercial information in the form of paid advertisement in order to defray operational costs of events, such as boat races.

Page #4 of the downloaded information from the above-cited Internet site shows a two-sided printing on the sail sheet. It would have been obvious for one skilled in the art to provide a two-sided printing of the informational material – which can be obtained by printing on each web of the sail sheet – in order to maximize exposure to the advertised matter.

Regarding the limitation “informational material remaining viewably undistorted whether the sheet is in a planar orientation or an airfoil orientation” in claims 1, 15 and 22, the phrase

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"viewably undistorted" has been interpreted to mean that the informational material remains "substantially undeformed, within the extent of being visually identifiable or recognizable". In this regard, the Examiner is of the opinion that as long as the printed matter remains identifiable or recognizable, it would not be considered distorted. Therefore, for extremely large printed information covering a substantial portion of the sail, no amount of sail stretching would cause a distortion to the point of being unrecognizable. Further, even for small printed matter, as long as the sail is subjected to only minor stretching, such matter would be displayed in an undistorted manner.

The Examiner wishes to point out that the independent claims 1 and 21 and its dependent claims are product-by-process claims, and are therefore considered as products claims. The product-by-process claims are not limited to the manipulations of the recited steps, only the end product obtained by the steps. (see MPEP 2113).

Regarding the process of cutting a sheet of material into a shape of a sail, it would have been obvious for one of ordinary skill in the art to know that the sail sheet must be cut into appropriate shape and size for manufacture and use as a sail. Further, it is also noted that the process of printing and cutting of the sail sheet may occur in any order, and is not considered critical to the invention. Such order would depend entirely on the practicality of the situation. In a mass production environment, if the sail is required to depicts the information matter pertinent to the manufacturer, it would be practical for the manufacturer to print the information on a continuous roll of sheet prior to cutting the sheet in different shapes for the sake of economy, convenience, and speed of manufacture. However, if a user is purchasing an already

manufactured sail, it would obviously be practical to print the information after the sail has been formed.

Regarding claim 5, it would have been an obvious design choice for someone skilled in the art to manufacture the sheet such that its weight is in the range of 10-30 ounces. Such weight would have provided proper balance between tear-resistance and stretchability of the material.

Similarly, regarding claim 12, it would have been an obvious design choice for someone skilled in the art to provide adhesion strength of the two webs of sheet to be 20 pounds per two inches of length. Such adhesion strength would have ensured maintenance of appropriate bonding strength between the two webs even in the extreme wind loading or other operational stresses on the sail.

8. Claims 1, 3-5, 7, 10-12, 14, 15, and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison ('934) in view of of the teaching of the Internet site

<http://na.northsails.com/Graphics/NGproducts.html> .

Ellison ('934) shows a stretch-oriented sail sheet (col. 5, line 26-27) having a woven polyester yarn laminated between at least two webs of PVC vinyl (column 3, line 52; column 4, line 34). The scrim yarn is cross-hatched in a predetermined directional pattern. The presence of the polyester yarn between the webs of PVC vinyl would provide some degree of opaqueness to the sail sheet.

Ellison ('934) is silent on:

- (i) informational matter being printed on to the sheet, or
- (ii) the sail material having a weight in the range of 15-30 ounces per square yard, or an adhesion strength of 20 pounds per two inches between the two webs of vinyl.

It would have been obvious for one skilled in the art at the time of the invention to have:

- printed informational matter on each vinyl web in the sail of Ellison according to the teaching of the above Internet site, such that the matter would remain viewable undistorted, and
- manufactured the sheet such that its weight is in the range of 10-30 ounces, as well as provided adhesion strength of the two webs of sheet to be 20 pounds per two inches of length.

for the same reasons as described above in the previous item # 7.

As described above, the independent claims 1 and 21 and its dependent claims are product-by-process claims, and are therefore considered as products claims. (see MPEP 2113)

Allowable Subject Matter

9. Claims 6, 13 and 16 would be allowable if:

- the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action is overcome, and
- The claims are rewritten to include all of the limitations of the base claim and any intervening claims.

Applicant is cautioned against introducing new matter

Note: The applicant is reminded that inclusion of new matter, which is not supported in the specification as originally filed, is not permitted. However, new matter may be introduced by filing a Continuation-In-Part (CIP) application.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 3-5, 7, 10-12, 14, 15, and 17-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (703) 306-5992. The examiner can normally be reached on Monday-Friday 1:00 pm--5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


AV

Ajay Vasudeva
Examiner
Art Unit 3617


S. JOSEPH MORANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600